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|-----------------|-------------|----------------------|---------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
| 08/862,039      | 05/22/97    | BIRD                 | D                   |

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DONALD S DOWDEN  
COOPER & DUNHAM  
1185 AVENUE OF THE AMERICAS  
NEW YORK NY 10036

PM82/0516

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| EXAMINER |
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BLUM, T

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| ART UNIT | PAPER NUMBER |
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3662

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DATE MAILED: 05/16/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/862039

Applicant(s)

BIRD

Examiner

T. BLUM

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 1-27-00
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-59 is/are pending in the application.  
Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-59 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

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1. Claims 1-59 are rejected since these claims recapture claimed subject matter deliberately canceled in application serial Number 07/978,272.

For example:

Claims 28-33 in serial Number 08/862,039 recapture subject matter from canceled claim 31 in serial Number 07/978,272.

Claim 31 in the patent, which recited the method of determining the location of the vehicle was rejected and canceled (combined with claim 10 to form allowable claim 39, renumbered as claim 7). Claim 31 contained detailed structure. Newly filed claim 28 attempts to recapture subject matter canceled (the method without the limitations of claim 10) but also broadened the claims in aspect directly related to the rejection of claim 31 in the in the patent file. Likewise claim 27, in the patent, recited apparatus of a similar scope to that of claim 31 and was canceled. Claim 30 of the reissue recaptures such canceled claim language, and additionally broadens

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that subject matter in an aspect directly related to the rejection of claim 27 of the patent file.

See M.P.E.P. 1412.02.

#### 1412.02 Recapture of Canceled Subject Matter [R - 2]

A reissue will not normally be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent\*> Ball Corp v. United States , 729 F.2d 1429, 221 USPQ 289, 295 (Fed. Cir. 1989);< In re Willingham , 282 F.2d 353, 127 USPQ 211 (CCPA 1960). \*\*>;< In re Richman , 161 USPQ 359, 363, 364 (CCPA 1969); \* In re Wadlinger, \*\*181 USPQ 826 (CCPA 1974). As \*>stated< by the \* >Federal Circuit< in Ball \*\*> : <

The recapture rule bars the patentee from acquiring, through reissue claims that are of the same or broader scope than those claims that were canceled from the

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original application. On the other hand, the patentee is free to acquire, through reissue, claims that are narrower in scope than the canceled claims. If the reissue claims are narrower than the canceled claims, yet broader than the original patent claims, reissue must be sought within 2 years after the grant of the original patent.

In the amendment filed January 27, 2000, Applicant discusses the second circumstance indicating that none of the claims are broader in all aspects than the canceled claims, and are in fact narrower in some aspects. Detailed justification of this position is requested.

With regard to the examples recited above, claim 31 in the patent application was canceled (combined with claim 10 to form allowable claim 39, renumbered as claim 7). Comparing new claim 28 to canceled claim 31; it is broader in all aspects, The patented claim 7 required the subject matter of claim 10 to be allowable. Therefore Applicant "surrendered" claimed subject matter not including the limitations of claim 10. Applicant argues that each claim is allowable over the references for various structural reasons (limitations). These limitations are what make the claims

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allowable and are required to remain in the reissue claims as the Applicant has “surrendered” subject matter not containing the limitations.

There are two ways to determine recapture: by comparison to canceled claims, and by determining what limitations made the patent claims allowable. A reissue claim can not be broader than a canceled claim in all aspects, and all reissue claims must retain at least one of the reasons (limitations) which made the patent claims allowable.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

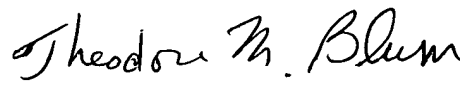
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. Any inquiry concerning this communication should be directed to Theodore Blum at telephone number (703) 305-1833.

Any inquiry concerning reissue procedures in general, should be directed to Mr. Steve Meyers (703) 308-3868 or Mr. Randy Reese (703) 308-2121.

  
THEODORE M. BLUM  
PRIMARY EXAMINER